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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/620,549
Filing Date: July 16, 2003
Appellant(s): SEITZ, PETER

Gregory A. Sebald
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/19/08 appealing from the Office action mailed 06/18/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,454,600	FLOYD	10-1995
5,885,229	YAMATO ET AL.	04-1999
6,345,839	KUBOKI ET AL.	02-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,454,600 to Floyd in view of USPN 5,885,229 to Yamato et al.

Floyd teaches an infinite array of images may be contained in an identification label (col. 4, lines 27-30) on substrates such as fabric, plastic, an article of clothing such as a shirt, or similar materials (equivalent to a personal item and cloth, col. 3, lines 25-28, col. 4, line 35). The printed image is applied to a designed label, ironed on a shirt for the purpose of identifying the child during an abduction (configured to be worn equivalency). See col. 1, lines 5-20 and lines 40-65, col. 2, line 3, lines 20-35 (instant claims 1-2, 4-7).

Floyd teaches the concept of providing printed pressure-distribution patterns, such as fingerprints, on items for identification purposes. However, Floyd does not teach an image having two-dimensional sampling of a pressure distribution pattern as claimed wherein differently colored and different shaded elements are present or

samplings or peak or mean values obtained configured to identify shoes worn by a person (instant claims 1-2, 4-7).

Yamato teaches a two-dimensional distribution patterns printed in different colors obtained by walking by foot as claimed (Abstract, col. 3, lines 10-45, col. 4, lines 1-30). Thus, it would have been obvious to one having ordinary skill in the art to have modified the identification label of Floyd to add the two-dimensional printout image of Yamato because Floyd suggests attaching any printed image to a personal item and Yamato teaches a printed pattern printed illustrating walking patterns obtained via walking as claimed. (Abstract, col. 3, lines 35-50, col. 12, lines 32-65, col. 17, lines 20-25, and lines 60-65). Furthermore, pattern choice is a design choice, and given little weight. Thus, in combination, Applicant's invention is taught. Claim 1-2, 4-7 are addressed. That patterns are configured to identify a shoe to be worn is to intended use; it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Further to claims 1 and 7, that an image is obtained by sampling by walking or impressed by a thermotransfer process for reproducing patterns are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed

and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 29 531. Both Applicant's and prior art reference's product are the same.

Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,454,600 to Floyd in view of USPN 6,345,839 to Kuboki et al.

Floyd teaches an infinite array of images may be contained in an identification label (col. 4, lines 27-30) on substrates such as fabric, plastic, an article of clothing such as a shirt, or similar materials (equivalent to a personal item and cloth, col. 3, lines 25-28, col. 4, line 35). The printed image is applied to a designed label, ironed on a shirt for the purpose of identifying the child during an abduction (configured to be worn equivalency). See col. 1, lines 5-20 and lines 40-65, col. 2, line 3, lines 20-35 (instant claims 13-17).

Floyd teaches the concept of providing printed pressure-distribution patterns, such as fingerprints, on items for identification purposes. However, Floyd does not teach an image having two-dimensional sampling of a pressure distribution pattern as claimed wherein differently colored and different shaded elements are present or samplings or peak or mean values obtained configured to identify pants worn by a person (instant claims 13-18).

Kuboki teaches a two-dimensional distribution patterns printed in different colors or shades obtained by sitting on a seat cushion where calculations of peak samplings are taken and printed as claimed (Abstract, shown in Figs. 21-27 and associated text, col. 5, lines 1-68, col. 7, lines 1-50, col. 15, lines 15-65).

Thus, it would have been obvious to one having ordinary skill in the art to have modified the identification label of Floyd to add the two-dimensional printout image pattern of Kuboki because Floyd suggests attaching any printed image to a personal item and Kuboki teaches a printed pattern printed illustrating patterns obtained via sitting on a seat cushion (Abstract, shown in Figs. 21-27 and associated text, col. 5, lines 1-68, col. 7, lines 1-50, col. 15, lines 15-65). Furthermore, pattern choice is a design choice, and given little weight. Thus, in combination, Applicant's invention is taught. Claim 13-17 are addressed. That patterns are configured to identify pants to be worn is to intended use; it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Further to claims 13 and 18, that an image is obtained by sampling by sitting or that an image is impressed by a thermotransfer process for reproducing patterns are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

(10) Response to Argument

Appellant argues that the identification device of the present application provides a basic and fundamentally different device than that shown in Floyd, Yamato et al or any combination thereof, namely because Appellant alleges Floyd's image would blend in with the environment and not be effective for identification. However, Appellant has not convincingly argued because Floyd's invention is to a personal identification label and explicitly teaches at col. 1, lines 15-22 that the purpose of making such a label is so a child may be positively identified when missing. The concealing or blending part comes from the fingerprint image being camouflaged with the label so it doesn't look like just a fingerprint and will therefore not draw attention to it (see col. 2, lines 33-36). Moreover, prints from fingers and feet are well known for inherently producing unique identification, such as experienced when babies are born and their footprints are inked to mark their identification on birth certificates. Appellant argues that Floyd and Yamato teach away from each other because Floyd is directed to labels for receiving fingerprints and Yamato is directed to walking patterns. However, this argument is not convincing because Yamato is the secondary reference used to teach that an image (while it is from walking and walking patterns inherently are produced from feet – see Figs. 8e and 9) may be derived from the way Applicant's instant claims are (while Appellant's specification is void of what process/machine is used to produce the two-pressure distribution pattern) as Yamato teaches the same two-dimensional pressure distribution pattern as a printout. See Abstract and col. 4, lines 1-5 to printing in different colors. Printouts are paper, and paper is the media labels are used, and thus the prior art is

analogous. That the fingerprint and footprints are different, is immaterial as they are still printed matter, and obvious to interchange because they are for the same identifiable purposes. One having skill in the art would replace the fingerprints of Floyd with the footprints of Yamato so one can identify a foot instead of a finger. For example, one could visualize a baby's footprint generated by a two-dimensional pressure distribution system of Yamato in place of the fingerprint of Floyd to fit inside the rabbit's foot shown in Fig. 1 for identifying a baby's foot also. Thus, it is not convincing that Appellant alleges there is no reason one would consider a walking pattern and employing it in any type of identification label.

Appellant argues Yamato does not teach or suggest identification through the pressure differences of a shoe contacting an object and configured to identify the pressure pattern of a shoe, however, Appellant does not claim the invention in this way. Claim 1 states the pattern is configured to identify a shoe or portion of a shoe worn by a person. The specification or claims do not explain how a pattern is configured to identify a shoe, however, because the walking pattern is of someone's foot, a fitted shoe would have the same pressure points of the foot that wears it. Regardless, of how finger or foot prints are obtained, the instant claims are merely descriptive of a patterned image. Printing patterns on a substrate is known in the art as provided by Floyd and Yamato set forth above and are purely decorative in nature. It has been held that mere printed matter having no new or unobvious functional relationship between the printed matter and the substrate is unpatentable. See *In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983). The court found that matters relating to ornamentation

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only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See *In re Seid* 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Tamra L. Dicus/

Conferees:

/Milton I. Cano/

Supervisory Patent Examiner, Art Unit 1794

/Gregory L Mills/

Supervisory Patent Examiner, Art Unit 1700